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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,888	11/09/2001	Katsuhiko Makino	020274-000100US	2247
20350 7590 02/11/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER JOHNSON, GREGORY L				
ART UNIT		PAPER NUMBER		
3691				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/990,888

Applicant(s)

MAKINO ET AL.

Examiner

GREGORY JOHNSON

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6-13, 15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 6-13, 15 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the amended application filed on November 26, 2007.

Status of Claims

2. Claims 1, 3-4, 6-13, 15 and 17-26 are pending. Claims 3, 15 and 17 are as previously presented. Claims 4, 6-11, 13 and 18-23 are original. Claims 1, 12 and 24-26 are amended. Claims 1, 3-4, 6-13, 15 and 17-26 have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-4, 6-13, 15, 7-24 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1, 12, 24 and 26 recite "the central system maintaining customer service information pertaining to *services not used by a customer but* offered by the establishment and associated with the customer" in the preamble of each claim. There is insufficient antecedent basis for this limitation in the claims.

The Examiner is unable to find any support for the phrase "services not used by a customer" in the specification. The Examiner has interpreted from the specification that "customer service information" is information associated with *all* services currently being offered by the bank. The specification recites in para. [09]:

Art Unit: 3691

[09]

The bank has a central system at a bank main office and a branch system, including ATMs, at a branch office. Customer attribute information (personal information associated with the customer) and **customer service information (information associated with services offered by the bank)** are stored at the central system and periodically transferred to the branch system. When a customer conducts a transaction at an ATM, customer specific information identifying the customer is generated.

For examination purposes, the Examiner will interpret "customer service information" to be "information associated with services offered by the bank", as recited in para. [09]. A reply to this Office Action should recite where support for "the central system maintaining customer service information pertaining to services not used by a customer" can be found. If unable to provide this information, appropriate corrections to the claims are required.

Claims 3-4, 6-11, 13, 15 and 17-23 are rejected because of their dependency on claims 1 and 12.

Examiner's Note: Applicants have amended claims 1, 12 and 24-26 to include the following "intended use" elements:

- for being used by the branch employee to promote services to the customer on-site at the branch;
- for use in providing personal attention to the customer in connection with the customer service information, the personal attention provided in-person at the branch by the branch employee to the customer;

- for use by the bank representative in providing personal, in-person attention to the customer at the branch office in connection with the customer service information;
- for use by a branch employee rather than the customer, in order to promote services to the customer on-site at the branch;
- for use in providing personal, in-person attention to the customer at the branch office in connection with the customer service information, for use by the branch representative rather than the customer, in order to promote services to the customer on-site at the branch office; and
- for being used by a bank representative at the branch office rather than the customer, to promote services to the customer on-site and the branch office.

These elements are preceded by one of the following specific functions:

- the report is provided to the branch employee
- the report identifying the customer and the customer service information; or
- the report received at the terminal is provided to a bank representative at the branch office.

The recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to be patentably distinguish from the claimed invention of the prior art. If the prior art structure is capable of performing the intended use, then the prior art meets the claim. See MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

However, the Examiner will provide prior art that teaches the intended use of the elements stated above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 3-4, 6, 8-13, 15 and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeanah et al., Pat. No. 5,933,816 (hereinafter Zeanah), in view of Horowitz et al., Pat. No. 6,349,290 (hereinafter Horowitz), Kolls, Pat. No. 6,622,124 (hereinafter Kolls), Michelle Clayton, New 'share of customer' innovations (hereinafter Clayton) and John Mahnke, Banking MIS challenged to develop next-generation self-service ATMs (hereinafter Mahnke).

As to claims 1, 12 and 24-26, Applicants amended the limitations of the claims. The rejection of the following limitations stand as being unpatentable over Zeanah and Horowitz as set forth in previous Office Action:

- transmitting a report on the customer from the branch system in response to the generation of customer-specific information at the self-service terminal,
- wherein the customer service information is updated at the branch system and provided to the central system after the employee provides the personal attention to the customer,
- the updated customer service information reflecting the reaction of the customer to the personal in-person attention with the customer service information and the status of any current transaction by the customer at the self-service terminal;
- wherein the customer service information is updated at the branch system and provided to the central system after the bank representative provides attention to the customer, the updated customer service information reflecting the reaction of the customer to the customer service information and the status of any current transaction by the customer at the self-service terminal; and
- wherein the network further comprises a second terminal for receiving the report from the branch system when the customer conducts a transaction at the ATM, wherein the second terminal is a stationary terminal located

within the branch, and wherein the report may include information on more than one customer within the branch office.

However, neither Zeanah nor Horowitz discloses or teaches the following limitations:

- the report identifying the customer and the customer service information and for being used by the branch employee to promote services to the customer on-site at the branch;
- a terminal for receiving a report from the branch system when the customer conducts a transaction at the ATM, the report identifying the customer and the customer service information;
- wherein the report is provided to the branch employee (i.e. bank representative), for use in providing personal attention to the customer in connection with the customer service information; and
- the personal attention provided in-person at the branch by the branch employee to the customer; and
- wherein the bank representative may obtain detailed customer information as part of the customer attribute information at the stationary terminal along with the report (e.g. performing a customer query into a database).

Clayton teaches a method for banks to maintain its deposit base and customers (Abstract). Clayton teaches the use of a system by NCR (AutoBank) that recording customer information in a Relational Database Management System (RDBMS). The recording of each customer transaction allows banks the ability to pinpoint which

services customers are using and other services that might better suit the banks' or customer's needs. Clayton also teaches that the information contained in the RDBMS is sent to tellers (i.e. branch offices) and customer service representatives in order to sell new loans and suggest new products (see page 4-5). In addition, Clayton teaches that a customer query can be performed on the database which would produce all facets of a customer's relationship with the bank, including how many accounts a customer has, what types, what the relationships are between them and the transaction history. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the system and method for delivering financial services of Zeanah, the recording and distributing of customer information as taught by Clayton since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable.

Neither Zeanah, Horowitz nor Clayton disclose or teach that the personal attention provided to the customer is delivered on-site and in-person.

However, Mahnke teaches MIS departments in banks are being challenged to develop and support next generation self-service technology (see page 1). Mahnke also teaches that with an integrated LAN, a salesperson could be informed that a customer is using an interactive customer service machine and that the salesperson could then go over to the customer and provide (in-person) assistance. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the

system and method for delivering financial services of Zeanah, the self-service technology as taught by Mahnke since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable.

Neither Zeanah, Horowitz, Clayton nor Mahnke disclose or teach the following limitation:

- wherein the report may include information on more than one customer within the branch office.

Kolls teaches a method where reports can be produced that contains each terminal transaction processing activity. Reports can be sorted by terminal, groups of terminals, and or by customer (col. 46, lines 31-44 and col. 47, lines 14-27). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the system and method for delivering financial services of Zeanah, the reporting procedures as taught by Kolls since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable.

The rejections of claims 3-4, 6, 9-11, 13, 15 and 19-23 stand as set forth in previous Office Action.

As to claims 8 and 18, Zeanah does not explicitly disclose the following limitations:

- wherein in response to the report being received at the terminal, the ATM displays a message.

However, Horowitz teaches a method and system for providing an automated customization and personalization presentation of product and service messages which supports any major interface access, such automated teller machines (ATM). Horowitz also teaches that the system is able to make decisions on various aspects, such as methods of interaction (automated or *assisted service*) with a customer (see para. 12, 16-17 and 20). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the system and method for delivering financial services of Zeanah, the customized and personalized messaging as taught by Horowitz since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable.

Neither Zeanah nor Horowitz discloses or teaches that the message would be:

- informing the customer that a bank representative will be approaching the customer to provide further customer service information.

However, Mahnke teaches that MIS departments in banks are being challenged to develop and support next generation self-service technology (see page 1). Mahnke also teaches that with an integrated LAN, a salesperson could be informed that a

customer is using an interactive customer service machine and that the salesperson could then go over to the customer and provide (in-person) assistance. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the system and method for delivering financial services of Zeanah and the customized and personalized messaging as taught by Horowitz, the in-person assistance as taught by Mahnke since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable.

9. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 12 above, and further in view of Bauchner et al., Pat. No. 6,029,153 (hereinafter Bauchner) as set forth in previous Office Action.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 3-4, 6-13, 15 and 17-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON
Examiner
Art Unit 3691